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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,568	10/20/2000	Karun Philip	12023-003001	7790

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225 FRANKLIN ST
BOSTON, MA 02110

EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 06/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/693,568

Applicant(s)

PHILIP ET AL.

Examiner

Narayanswamy Subramanian

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mw

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Original claims 1-24 have been examined. The objections and rejections are stated below.

Drawings

2. This application has been filed with informal drawings, which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Specification

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said" should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The abstract of the disclosure is objected to because it is too long. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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5. With regard to claims 8-12 and 16, the claims are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 8-12 and 16 are directed to non-statutory subject matter because they lack any recitation of technology in the body of the claims, which is required in order to meet the statutory requirements. The Patent Office has taken the position that some form of technology must be claimed in the body of the claim. The Board of Patent Appeals and Interferences has stated that claims lacking any technology are “nothing more than [an] abstract idea which is not tied to any technological art and is not a useful art as contemplated by the Constitution.” *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001)(Unpublished). While it is understood that the Bowman case is not precedential, it is cited herein for its content and reasoning.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(c) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

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Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1, 2, 4, 5, 8-13, 15-18, and 20-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Field (US Patent 6,073,104).

With reference to claim 1, Field teaches a system for managing financial assets comprising: a computer system to receive information regarding financial assets (See Field Figure 2, Column 5 lines 24-50); a storage system coupled to the computer system, the mass storage system storing the information (See Field Column 6 lines 30-67), and a computer program to execute on the computer system, comprising computer instructions to cause the computer system to: segregate the financial assets into a first category and a second category according to a first set of rules (See Field claims 26 and 27); and segregate the financial assets contained within a first one of each of the first and second categories into asset classes according to a second set of rules (See Field claims 28-30).

With reference to claims 8 and 17, Field teaches a method and a computer program product stored on a computer readable medium, for managing accounts receivable, the method comprising of: providing a pool of financial assets (See Field Claim 26); abstracting information regarding a subgroup of the financial assets within the pool according to at least a first abstraction rule (See Field claims 26 and 27); summarizing the information provided by operation of the first abstraction rule (See Field Column 6 lines 49-50); providing information regarding individual financial assets within the subgroup of the pool according to at least a second rule (See Field claims 26 and 27). A computer program product stored on a computer readable medium is inherent in the disclosure.

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With reference to claims 2, 9, 16 and 18, Field teaches the step wherein the financial assets comprise accounts receivable (See Field claims 26 and 27 and Column 1 lines 16-25).

With reference to claims 4 and 5, Field teaches a computer program comprising instructions to cause the computer system to reconcile a transaction related to an financial asset (See Field Claim 14) and to manage an exception related to the transaction (See Field Column 9 lines 24-30)

With reference to claims 10, 11, 20 and 21, Field teaches the step wherein abstracting further comprises: abstracting information using a hierarchy of abstraction rules to define hierarchical subsets of the pool of financial assets (See Field claims 28-30) and representing the hierarchy of abstraction rules as a tree structure defined by the hierarchy of abstraction rules (See Field claims 28-30).

With reference to claims 12, 13, 15, 22 and 23, Field teaches the step wherein producing a report concerning individual financial assets within the subgroup of the pool according to the at least first abstraction rule with producing being constrained by the at least second rule and requesting the reports based on the at least first rule through a client system that is coupled to a server system over the Internet (See Field Column 6 lines 4-17, Column 7 line 36 – Column 8 line 34) The network is interpreted to include the Internet also.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3, 6, 7, 14, 15, 19 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Field (US Patent 6,073,104).

With reference to claims 3, 6, 7, 14, 19 and 24, Field teaches a system, method and a computer program product of claims 1, 8 and 17 as discussed above.

Field does not explicitly teach the steps wherein the computer system receives information regarding transactions related to individual assets in real-time and a scanner to scan a document related to a financial asset to make a scanned image, to store the scanned image on the mass storage system and display scanned images to an authorized user upon request.

Official notice is taken that these steps are old and well known in the art. Receiving information regarding transactions in real-time keeps the user informed in a timely manner and having a scanner to scan a document related to a financial asset to make a scanned image, to store the scanned image on the mass storage system and display scanned images to an authorized user upon request helps in quicker and efficient retrieval of a copy of the desired document by the authorized user.

It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine these steps to the disclosure of Field. The combination of the disclosures taken as a whole, suggests that the user would have benefited from being informed in a timely manner and from being able to access the information they need quickly and efficiently.

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Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to the Patent Office is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian
June 11, 2004

Richard Weisberger
Primary Examiner